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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,575	11/28/2003	Martin Broberg	TPP 31708	4961

7590 08/10/2007

STEVENS, DAVIS, MILLER & MOSHER, L.L.P.
Suite 850
1615 L Street, N.W.
Washington, DC 20036

EXAMINER	
GOFF II, JOHN L	

ART UNIT	PAPER NUMBER
1733	

MAIL DATE	DELIVERY MODE
08/10/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/722,575	BROBERG ET AL.	
	Examiner	Art Unit	
	John L. Goff	1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 July 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12 and 14-58* is/are pending in the application.

4a) Of the above claim(s) *3,5-9,18-23 and 56-58* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4,10-12,14-17 and 24-55* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☒ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/10/07 has been entered.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Objections

3. Claim 32 is objected to because of the following informalities: In claim 32, line 2 delete "byat" and insert therein - - by at - -. Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 2, 4, 10-12, 14-17, 30-32, and 37-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sjoberg et al. (WO 02/47906) in view of any one of Mason (U.S. Patent 1,995,264), Berry et al. (U.S. Patent 4,406,455), or Karam (U.S. Patent 6,485,823) and Moebus (WO 01/21366 and see also English equivalent U.S. Patent 6,761,961).

Sjoberg et al. disclose a method of manufacturing a decorative laminate used for floor coverings comprising providing a carrying core layer, e.g. fiber board, providing a dampening (e.g. acoustic dampening) foil layer of a thermoplastic elastomer on the upper side of the core layer, providing an uppermost decorative and abrasion resistant thermosetting laminate layer on the foil layer, and then pressing to form the decorative laminate (Page 1, lines 17-26 and Page 2, lines 12-14). Sjoberg et al. are silent as to the lower side of the core layer consisting of a balance layer. Mason discloses a method of manufacturing a decorative laminate used for floor coverings comprising adhering a core layer to an upper layer and an identical/symmetrical lower layer wherein the upper layer includes a decorative and abrasion resistant layer and the lower layer is added to balance the upper layer and prevent the decorative laminate from warping while also providing the capability of reversing the decorative laminate in the event the upper layer is damaged or it is desired to expose the decorative pattern provided on the lower layer (Figures 1-3 and Page 1, lines 1-6, 29-32, and 38-48 and Page 2, lines 40-46 and 14-28). Berry et al. disclose a method of manufacturing a decorative laminate used for floor coverings comprising adhering a core layer to upper layers and identical/symmetrical lower layers wherein the upper layers include decorative and abrasion resistant layers and the lower layers are added to balance the

upper layers and prevent the decorative laminate from warping (Figure 3 and Column 4, lines 51-68 and Column 5, lines 1-2). Karam discloses a method of manufacturing a decorative laminate used for floor coverings comprising adhering a core layer to upper layers and identical/symmetrical lower layers wherein the upper layers include decorative and abrasion resistant layers and the lower layers act to balance the upper layers (Figure 1 and Column 4, lines 61-64 and Column 5, lines 32-35). It would have been obvious to one of ordinary skill in the art at the time the invention was made to join on the lower side of the core layer taught by Sjoberg et al. a balance layer that is identical/symmetrical with the layers on the upper side of the core layer, i.e. a balance layer including the dampening foil layer of thermoplastic elastomer and the decorative and abrasion resistant thermosetting laminate layer, as shown by any one of Mason, Berry et al., or Karam to prevent the decorative laminate from warping and provide the capability of reversing the decorative laminate in the event the upper layers of the decorative laminate are damaged or it is desired to expose the decorative pattern provided on the lower layers.

Regarding claim 1, Sjoberg et al. do not specifically teach the decorative laminate is cut into panels and provided with edges intended for joining, it being noted Sjoberg et al. teach the decorative laminate is used for floor coverings (Page 1, lines 6-8). Moebus discloses a method of manufacturing a decorative laminate used for floor coverings comprising providing a carrying core layer, providing an upper decorative and abrasion resistant laminate layer on the upper side of the core layer, pressing to form the decorative laminate, and then cutting the decorative laminate into panels and milling edges on the cut panels intended for joining together as a floor covering (Column 1, lines 15-47 of U.S. Patent 6,761,961). It would have been obvious to one

of ordinary skill in the art at the time the invention was made to include in Sjoberg et al. as modified by any one of Mason, Berry et al., or Karam the well known finishing steps for forming decorative laminates into floor coverings of cutting the decorative laminate into panels and milling edges on the cut panels intended for joining as shown for example by Moebus wherein only the expected results would be achieved.

Regarding claims 2, 10-12, 37, 38, 46, 47, 50, 54, and 55, Sjoberg et al. further teach the decorative and abrasion resistant laminate is formed by providing one or more underlay papers impregnated with phenol-formaldehyde resin, providing on the underlay papers one or more décor papers impregnated with melamine-formaldehyde resin, providing on the décor papers one or more overlay sheets impregnated with melamine-formaldehyde resin and hard particles such as silicon oxide, aluminum oxide, silicon carbide, etc. having an average size of 5 - 60 μm, and laminating the papers together under increased heat and pressure to form the upper decorative and abrasion resistant laminate having a thickness of 0.3 - 0.9 mm and a density of 1250 - 1500 kg/m^3 (Page 1, lines 27-28 and Page 2, lines1-11).

Regarding claims 39-42 and 51-53, Sjoberg et al. teach the dampening foil is a thermoplastic elastomer having an elasticity compression coefficient of 0.8 - 2.0 Mpa, a thickness of 0.1 - 0.5 mm, and a density of 180 - 330 kg/m^3 (Page 2, lines 15-22).

Regarding claims 17, 30-32, and 43-45, Sjoberg et al. teach the upper decorative and abrasion resistant laminate, dampening foil, and carrying core layer are joined by means of melt-glue, heat, and pressure wherein Sjoberg et al. as modified by any one of Mason, Berry et al., or Karam is considered to join the balance layer to the core layer by the same (Page 2, lines 23-27).

Regarding claims 14-16, 48, and 49, as noted above Sjoberg et al. teach the dampening foil is a thermoplastic elastomer having an elasticity compression coefficient of 0.8 - 2.0 Mpa, a thickness of 0.1 - 0.5 mm, and a density of 180 - 330 kg/m^3, and Sjoberg et al. teach the decorative and abrasion resistant laminate has a thickness of 0.3 - 0.9 mm and a density of 1250 - 1500 kg/m^3. Absent any unexpected results, it would have been obvious to one of ordinary skill in the art at the time the invention was made to experimentally determine the thickness, density, and elasticity compression coefficient of the balance layer as a whole as taught by Sjoberg et al. as modified by any one of Mason, Berry et al., or Karam within the ranges of the individual components disclosed by Sjoberg et al. for the dampening foil and decorative and abrasion resistant laminate as a function of providing a balance layer that prevents the decorative laminate from warping as doing so would have required nothing more than ordinary skill and routine experimentation.

6. Claims 24-26, 29, and 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sjoberg et al., any one of Mason, Berry et al., or Karam, and Moebus as applied to claims 1, 2, 4, 10-12, 14-17, 30-32, and 37-55 above, and further in view of Leukel et al. (U.S. Patent 4,770,916).

Sjoberg et al., any one of Mason, Berry et al., or Karam, and Moebus as applied above teach all of the limitations in claims 24-26, 29, and 33-36 except for a teaching of including a conductive material such as carbon black or carbon fiber in the glue and elastomer layers. Leukel et al. disclose a floor covering including rubber and glue layers wherein the layers include a conductive material such as carbon black or carbon fiber (conductivity greater than 500 $k\Omega cm$) to impart static dissipating properties to the floor covering (Column 3, lines 5-9 and 36-

49 and Column 4, lines 59-60). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include in the glue and elastomer layers of Sjoberg et al. as modified by any one of Mason, Berry et al., or Karam, and Moebus a conductive material such as carbon black or carbon fiber to impart static dissipating properties to the decorative laminate floor covering as shown by Leukel et al.

7. Claims 24 and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sjoberg et al., any one of Mason, Berry et al., or Karam, and Moebus as applied to claims 1, 2, 4, 10-12, 14-17, 30-32, and 37-55 above, and further in view of Nowell et al. (U.S. Patent 4,885,659).

Sjoberg et al., any one of Mason, Berry et al., or Karam, and Moebus as applied above teach all of the limitations in claims 24 and 27-29 except for a teaching of including a conductive material such as a vacuum metallized aluminum layer in the thermoplastic layer of the balance layer. Nowell et al. disclose a floor covering including a thermoplastic layer wherein the thermoplastic layer includes a conductive material such as a vacuum metallized aluminum layer (conductivity greater than 500 kΩcm) to impart static dissipating properties to the floor covering (Column 2, lines 3-18 and Column 4, lines 18-27). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include in the thermoplastic layers of Sjoberg et al. as modified by any one of Mason, Berry et al., or Karam, and Moebus a conductive material such as a vacuum metallized aluminum layer to impart static dissipating properties to the decorative laminate floor covering as shown by Nowell et al.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1, 2, 4, 10-12, 14-17, 30-32, and 37-55 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 and 13-16 of U.S. Patent No. 6,893,713 in view of any one of Mason, Berry et al., or Karam, and Moebus. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-11 and 13-16 of U.S. Patent No. 6,893,713 disclose the invention substantially as claimed except for teaching of including a balance layer comprising a thermoplastic elastomer on the lower side of the core layer and cutting the decorative laminate into panels and providing the panels with edges intended for joining which would have been obvious as discussed above.

10. Claims 24-26, 29, and 33-36 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 and 13-16 of U.S. Patent No. 6,893,713, any one of Mason, Berry et al., or Karam, and Moebus as applied to claims 1, 2, 4, 10-12, 14-17,

30-32, and 37-55 above, and further in view of Leukel et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-11 and 13-16 of U.S. Patent No. 6,893,713, any one of Mason, Berry et al., or Karam, and Moebus disclose the invention substantially as claimed except for a teaching of including a conductive material in the glue and elastomer layer which would have been obvious as discussed above.

11. Claims 24 and 27-29 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 and 13-16 of U.S. Patent No. 6,893,713, any one of Mason, Berry et al., or Karam, and Moebus as applied to claims 1, 2, 4, 10-12, 14-17, 30-32, and 37-55 above, and further in view of Nowell et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-11 and 13-16 of U.S. Patent No. 6,893,713, any one of Mason, Berry et al., or Karam, and Moebus disclose the invention substantially as claimed except for a teaching of including a conductive material in the thermoplastic layer which would have been obvious as discussed above.

12. Claims 1, 2, 4, 10-12, 14-17, 30-32, and 37-55 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 5-7, and 9-22 of copending Application No. 11/129,497 in view of any one of Mason, Berry et al., or Karam, and Moebus. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 2, 5-7, and 9-22 of copending Application No. 11/129,497 disclose the invention substantially as claimed except for teaching of including a balance layer comprising a thermoplastic elastomer on the lower side of the core layer and cutting the decorative laminate into panels and providing the panels with edges intended for joining which would have been obvious as discussed above.

This is a provisional obviousness-type double patenting rejection.

13. Claims 24-26, 29, and 33-36 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 5-7, and 9-22 of copending Application No. 11/129,497, any one of Mason, Berry et al., or Karam, and Moebus as applied to claims 1, 2, 4, 10-12, 14-17, 30-32, and 37-55 above, and further in view of Leukel et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 2, 5-7, and 9-22 of copending Application No. 11/129,497, any one of Mason, Berry et al., or Karam, and Moebus disclose the invention substantially as claimed except for a teaching of including a conductive material in the glue and elastomer layer which would have been obvious as discussed above.

This is a provisional obviousness-type double patenting rejection.

14. Claims 24 and 27-29 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 5-7, and 9-22 of copending Application No. 11/129,497, any one of Mason, Berry et al., or Karam, and Moebus as applied to claims 1, 2, 4, 10-12, 14-17, 30-32, and 37-55 above, and further in view of Nowell et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 2, 5-7, and 9-22 of copending Application No. 11/129,497, any one of Mason, Berry et al., or Karam, and Moebus disclose the invention substantially as claimed except for a teaching of including a conductive material in the thermoplastic layer which would have been obvious as discussed above.

This is a provisional obviousness-type double patenting rejection.

Response to Arguments

15. Applicant's arguments filed 6/12/07 have been fully considered but they are not persuasive.

Applicants arguments regarding the previous 35 USC 112 first paragraph rejection are persuasive, and the rejection is withdrawn.

Applicants argue, "Specifically, according to the present claims, the laminate is defined by an uppermost layer of abrasion resistant thermosetting laminate layer and dampening foil, while the bottom layer consists of the balance layer. In contrast, the combination of teachings relied upon by the Office Action would produce a different product, i.e., having a bottom layer being something other than one consisting of the balance layer. As the purpose the lower layers (which, according to the Office Action are "identical/symmetrical" to the upper layers) is to provide the capability of reversing the product, if the lower side of the core comprises the balance layer, such is not possible. Thus, since the purpose of the secondary references would be defeated by making the claimed combination, Applicants respectfully submit that one of ordinary skill in the art would not have been motivated to produce the claimed product. Reconsideration is respectfully requested.".

The laminate taught by Sjoberg et al. as modified by any one of Mason, Berry et al., or Karam is defined by an uppermost layer of abrasion resistant thermosetting laminate layer and dampening foil, while the bottom layer consists of a balance layer. The limitation "that the lower side of the core consists of a balance layer" is not interpreted as consisting of a single layer as the balance layer claimed by applicants includes a polymer layer (Claim 1), a glue layer (Claims 43 and 45), and a metal layer (Claims 27 and 28). Thus, the balance layer taught by Sjoberg et al. as

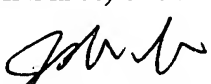
modified by any one of Mason, Berry et al., or Karam including a glue layer, a polymer layer, and an abrasion resistant thermosetting laminate layer is considered a balance layer, it being additionally noted the balance layer prevents warping of the laminate which is consistent and in agreement with that disclosed in applicants specification as a "balance layer".

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John L. Goff** whose telephone number is **(571) 272-1216**. The examiner can normally be reached on M-F (7:15 AM - 3:45 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



John L. Goff
Primary Examiner
Art Unit 1733